Office-Supreme Court, U.S.
FILED
JUL 15 1965
JOHN F. DAVIS, CLERK

IN THE

# Supreme Court of the United States

OCTOBER TERM, 1965

No. 253

MOHASCO INDUSTRIES, INC.,
*Petitioner,*

*vs.*

E. T. BARWICK MILLS, INC.,
and
BARWICK CARPET MILLS, INC.,
*Respondents.*

## RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

CHARLES H. WALKER
*Attorney for Respondents*
FISH, RICHARDSON & NEAVE
277 Park Avenue
New York, N. Y. 10017

*Of Counsel:*
M. COOK BARWICK
Wilson, Branch, Barwick
and Vandiver
615 Rhodes-Haverty Building
Atlanta 3, Georgia

ALBERT E. FEY
Fish, Richardson & Neave
277 Park Avenue
New York, N. Y. 10017

July 15, 1965

The patents in suit are:

| | |
|---|---|
| Odenweller No. 2,853,032 | (IV 1413) |
| Crawford No. 2,853,033 | (IV 1418) |

The opinions of the Courts below:

| | |
|---|---|
| District Court Opinion, 221 F. Supp. 191-205 | (Petitioner's Appendix B, pp. 4a-33a) |
| Court of Appeals Opinion, 340 F. 2d 319 | (Petitioner's Appendix B, p. 34a) |
| Court of Appeals denial of rehearing, 342 F. 2d 431 | (Petitioner's Appendix B, p. 36a) |

## TABLE OF CONTENTS


PAGE

1. The Decisions below Are Not Impugned by the Fact that the District Court Agreed with Respondents' View of the Case and Based Its Opinion and Findings Largely on Respondents' Brief and Proposed Findings ..... 2

2. The Decisions of Invalidity Were Plainly Right .. 4

3. The Holding of Non-infringement Is Proper and in Accordance with Long-established Law ..... 10

Conclusion ..... 12


## APPENDICES


Appendix A—Sheet of drawings from Thompson patent No. 2,781,007 (V 1884)

Appendix B—Pull-out sheet containing photographs of various models which were trial exhibits:

Sheet 1—Intermeshing Gears (DX-5A) (V 1984)

Sheet 2—Variable Feed by Intermeshing Slats on Drums (DX-6A) (V 1985)

Sheet 3—Variable Feed by Intermeshing Slats on Chains or Drums (DX-7A) (V 1986)

Sheet 4—Variable Feed by Intermeshing Slats on Chains (DX-8A) (V 1987)

Sheet 5—Model Tufting Machine with Slat Pattern Attachment (DX-9A) (V 1988)

## TABLE OF AUTHORITIES


PAGE

CASES:

*Chicopee Mfg. Corp.* v. *Kendall Co.*, 288 F. 2d 719 (4 Cir. 1961), cert. denied 368 U. S. 825 (1961) 2–3

*Concrete Appliances Co.* v. *Gomery*, 269 U. S. 177 (1925) ..... 10

*Graham* v. *Jeoffroy Mfg.*, 206 F. 2d 769 (5 Cir. 1953) ..... 10

*Graver Mfg. Co.* v. *Linde Co.*, 336 U. S. 271 (1949) 12

*Keller* v. *Adams-Campbell Co.*, 264 U. S. 314 (1924) 12

*McElrath* v. *Industrial Rayon Corporation*, 123 F. 2d 627 (4 Cir. 1941) ..... 10

*Roberts* v. *Ross*, 344 F. 2d 747 (3 Cir. April 29, 1965) ..... 3–4

*Safety Car Heating & Lighting Co.* v. *General Elec. Co.*, 155 F. 2d 937 (2 Cir. 1946) ..... 9–10

*Thomson Co.* v. *Ford Motor Co.*, 265 U. S. 445 (1924) ..... 10

*Toledo Co.* v. *Standard Parts*, 307 U. S. 350 (1939) 10

*Westinghouse* v. *Boyden Power Brake Co.*, 170 U. S. 537 (1898) ..... 11

STATUTE:

35 U. S. C. § 103 ..... 1n

IN THE

# Supreme Court of the United States

OCTOBER TERM, 1965

| | |
|---|---|
| MOHASCO INDUSTRIES, INC., *Petitioner,* *vs.* E. T. BARWICK MILLS, INC., and BARWICK CARPET MILLS, INC., *Respondents.* | No. 253 |

## RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

This is a suit for the alleged infringement of two patents relating to the manufacture of tufted carpet.

The patents were held by both courts below to be invalid and not infringed.

The decisions of invalidity were soundly based on the factual conclusion of both courts that the subject matter was obvious to persons skilled in the art and hence unpatentable under 35 U. S. C. § 103.*

No unusual point of law is involved, and there has been no other decision with respect to the patents; there is no valid reason for granting the writ.

---

*"§ 103. Conditions for patentability; non-obvious subject matter

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

**1. The Decisions below Are Not Impugned by the Fact that the District Court Agreed with Respondents' View of the Case and Based Its Opinion and Findings Largely on Respondents' Brief and Proposed Findings**

In the first of its three reasons for granting the writ, petitioner seeks to invoke this Court's supervisory powers on the ground that the District Court "shirked its judicial duties" because it adopted from respondents' pre-trial brief, and included in its opinion, much of a discussion of the law concerning the requirement of "invention" (including a discussion of the pertinent decisions of this Court), which petitioner characterizes as "permeated with a philosophy antagonistic to the patent system and to patentees." Petitioner also complains because the District Court adopted, with only minor changes, proposed findings of fact submitted by respondents.

Petitioner overreaches in citing *Chicopee Mfg. Corp.* v. *Kendall Co.*, 288 F. 2d 719, 724 (4 Cir. 1961), cert. denied 368 U. S. 825 (1961) in support of its criticism of the District Court's use of respondents' trial brief and proposed findings, for what occurred and was properly condemned in *Chicopee* was wholly different from what occurred in this case. In the present case briefs and proposed findings were submitted by both parties as an *inter partes* matter; in *Chicopee*, the opinion adopted by the Court was prepared and submitted to the Court by counsel for one of the parties without the knowledge of the other party. In the same paragraph of the Court's opinion as that in which the adoption of such an opinion was condemned as a denial of due process, the Court acknowledged the propriety of the procedure followed in the present case, saying (p. 724):

> "There is authority for the submission to the court of proposed findings of fact and conclusions of law by the attorneys for the opposing parties in a case,

and the adoption of such of the proposed findings and conclusions as the judge may find to be proper. See United States v. Crescent Amusement Co., 323 U. S. 173, 184, 65 S. Ct. 254, 89 L. Ed. 160; Saco-Lowell Shops v. Reynolds, 4 Cir., 141 F. 2d 587, 589; Schilling v. Schweitzer-Cummings Co., 79 U. S. App. D. C. 20, 142 F. 2d 82, 83; Simons v. Davidson Black Co., 9 Cir., 106 F. 2d 518; O'Leary v. Liggett Drug Co., 6 Cir., 150 F. 2d 656, 667."

The recent decision in *Roberts* v. *Ross,* 344 F. 2d 747 (3 Cir. April 29, 1965), which petitioner brings to this Court's attention in a motion for leave to supplement its petition, serves to emphasize the lack of merit in petitioner's contention for in it the Court expressly approves the procedure followed by the District Court in the present case, saying (p. 752):

> "We did not then [in one of its own earlier decisions], and do not now, mean to suggest that a trial judge should not have the right to invite counsel for both parties to submit to him proposed findings of fact and conclusions of law, accompanied by briefs if he desires them, to assist him in formulating his own findings and conclusions and reaching his decision. In the process of studying the facts and the law, findings and conclusions formulated and proposed by the parties may be most helpful to the judge in sharpening the issues and may serve a very useful purpose in aiding him in drafting his own findings and conclusions.[3] In most cases it will appear that

---

"[3]See the excellent discussion of the subject by the Court of Appeals for the Second Circuit in The Jemson No. 1, 1941, 123 F. 2d 999, 1001. See also the illuminating discussion by Judge Gunnar H. Nordbye, Improvements in Statement of Findings of Fact and Conclusions of Law, 1940, 1 F. R. D. 25, 30, and Judge J. Skelly Wright, The Nonjury Trial—Preparing Findings of Fact and Conclusions of Law, Seminars for Newly Appointed United States District Judges, West Pub. Co., 1963, pp. 159, 166."

many of the findings proposed by one or the other of the parties are fully supported by the evidence, are directed to material matters and may be adopted verbatim and it may even be that in some cases the findings and conclusions proposed by a party will be so carefully and objectively prepared that they may all properly be adopted by the trial judge without change.[4]"

---

"[4]Most of the reported cases which have approved findings and conclusions which the trial judge has adopted in the form prepared by counsel without change involve findings and conclusions submitted before decision. And in many of the cases which involve findings and conclusions submitted after decision the trial judge filed an opinion or memorandum decision which outlined his findings and conclusions and thus afforded counsel information from which to formulate detailed findings and conclusions for him."

## 2. The Decisions of Invalidity Were Plainly Right

Petitioner's second reason for granting the writ attempts to take advantage of the circumstance that this Court has already granted certiorari in five patent cases, each involving the application of 35 U. S. C. Sec. 103, asserting that the present case would afford the Court an opportunity to discuss the meaning of that section from some standpoint different from what will be afforded by the other cases. We disagree and submit that the only practical result of granting a writ in the present case would be to put the Court under the necessity of examining a mass of evidence bearing on the extent to which the subject matter of these patents was obvious or unobvious to persons skilled in this art.

The lack of necessity for that exercise and its inappropriateness from the standpoint of the use of the time of this Court will be evident from the following brief description of the subject matter of the patents and the

very minor departure which they represent from the prior art:

The patents are concerned with pattern attachments by means of which patterns of high and low loops can be formed in the surface of tufted carpets.

The process of tufting (pushing loops of yarn through a backing) has long been used for making decorated bedspreads, but has been applied only recently to the manufacture of carpets. Tufted carpet as first made around 1950 was a somewhat sleezy product but since then various improvements (unrelated to the patents here in suit) have been made with the result that present-day tufted carpet is fully competitive with woven carpet.

A tufting machine consists, in substance, of a row of needles mounted in a bar extending across the width of the machines and arranged to be reciprocated vertically so as to insert loops of yarn in a backing sheet as it is advanced through the machine. Each needle acts in precisely the same manner as every other needle so the operation can be understood by consideration of the operation of a single needle; the rest of the machine is mere proliferation, adding apparent, but not real, complexity.

Each needle has an eye near its point and, as the descending needle penetrates the backing sheet, it pulls with it a loop of the pile yarn which is threaded through the eye. When a loop has been inserted in this way, it is temporarily held in position, as the needle withdraws on its upward stroke, by a small hook called a "looper" mounted underneath the backing sheet. Successive loops are formed in the same way by successive reciprocations of the needle as the backing sheet is advanced step by step through the machine. The relationship between the needle and looper in forming successive loops is shown in a sheet of drawings from a Thompson patent, which is included at the back of this brief as an appendix.

The ultimate length of each loop in the finished product is not determined by the depth of penetration of the needles, as one might at first think. In normal operation a loop, when first inserted, is of a length determined by the penetration of the needle and the location of the looper. But when the next loop is formed, the amount of yarn supplied by the feed to the needle will be somewhat less than the length of yarn required to form a full length loop. Accordingly, the descending needle will make up the deficiency in the feed by withdrawing the necessary amount of yarn from the immediately preceding loop, shortening it somewhat from its original length. This process, called "backdrawing," serves the beneficial purpose of tightening the back stitch as well as producing tufts of uniform length.

As will be evident from the foregoing, a tufting machine adjusted to produce loops of a given height can be made to produce higher loops by increasing the rate of yarn feed so as to reduce the amount of backdrawing. Conversely, to make the machine produce shorter loops the yarn feed is reduced so as to require more yarn to be withdrawn from the previously formed loops and thereby shorten them.

The dependence of pile height on the rate of yarn feed was well understood in this art prior to any activity of either of the patentees, and knowledge of this relationship was used not only to adjust the pile height of plain surface carpet but also to produce patterns of high and low loops. Indeed, an "interference" occurred in the Patent Office between the applications of nine different claimants to inventorship of the process of producing patterns of high and low loops by appropriately restricting the feed of yarn to the several needles. The interference was ultimately settled, and a patent on the basic process was awarded to one of the applicants, Boyles (V 1915). (Patents were also awarded to each of the other applicants on one or another feature of the machines by which they proposed to practice

this process.) The Boyles patent, covering the use of the basic backdrawing process to produce patterns of high and low loops, was one of several patents relating to the same general subject which were acquired by a patent holding company called Tufted Patterns, created for the purpose, and under whose patents respondents were and still are licensed (V 2136-2137).

Several methods exist for controlling the rate of feed of yarn. One is to run it in an S-shape over a pair of rolls and to vary the speed of rotation of the rolls. Another is to provide a pair of rolls running at different speeds and move the yarn into contact with one or the other of those rolls. Still another is to pass the yarn between a pair of intermeshing elements, such as gears, whose degree of intermesh can be varied. This last method of using intermeshing elements, whose degree of intermesh is variable, is the basis for feeding devices known as furnishing wheels in the knitting art and is also the basis for the patents here in suit.

The manner in which the rate of yarn feed is controlled in a feeding device depending on the use of intermeshing elements is simple and straightforward. The yarn as it passes between the intermeshing elements necessarily follows a zig-zag path. This is shown in relation to a pair of intermeshing gears, representing an elementary furnishing wheel, in the left-hand figure on the pull-out at the back of this brief. When the intermeshing gears are rotated enough to release a length of yarn previously imprisoned between a pair of intermeshing teeth, the length of yarn released will correspond to the degree of intermesh. To illustrate, if the right-hand gear in the figure, which is movable toward and away from the mating gear, is moved away (to the right) the degree of intermesh is reduced and so is the length of each increment of yarn as successive zig-zag waves of yarn are released from engagement with

the pair of intermeshing teeth between which it was previously restrained.

In the Odenweller patent in suit, the principle of operation is the same; the amount of yarn fed by each increment of rotation of two members with intermeshing elements is varied by varying the degree of intermesh. In Odenweller, which is represented by the model shown in the second picture from the left in the series of five on the pull-out at the back of this brief, one of the rotating elements (the one on the right) is a cog or pinion having intermeshing teeth or elements of uniform height. The teeth on the other rotating element (on the left) are of varying heights. When the yarn is released from engagement with a tall tooth, a correspondingly long length of yarn will be released. When a short tooth comes into the zone of engagement, a correspondingly short length will be released. By suitably varying the height of the teeth, the rate of yarn feed can be varied in such a way as to produce successive loops of heights which vary in accordance with whatever pattern the designer wishes.

To facilitate the explanation, the foregoing description has been concerned with only a single yarn, fed between a single pair of intermeshing elements. But, as previously noted, the operation of every needle in a tufting machine is the same as that of every other needle. The same is true of the feeding mechanism. In a machine having 1000 needles for producing carpet 15 feet wide, the rotating members comprising the feeding mechanism would be correspondingly long. Each individual end of yarn would have its own established path between the intermeshing elements *en route* to its own individual needle and the rate of feed of each individual end of yarn would be established and controlled in exactly the same way as the single end shown in the pull-out figure, by varying the depth of the notch cut in each of the variable height elements to establish its path of travel.

The device of the Odenweller patent, involving intermeshing teeth mounted on the surfaces of a pair of drums, was never put into commercial use. But early in his consideration of the matter Odenweller realized that either or both of the intermeshing elements could be mounted on chains instead of on a drum (V 2102), as shown in the third picture on the pull-out. Crawford, of Mohasco, in his subsequently devised version of such a feeding device, mounted the intermeshing elements or teeth on chains instead of drums, as shown in the fourth picture on the pull-out.

To complete the series of pictures on the pull-out, the fifth picture shows such a device producing a succession of loops of varying height, corresponding to varying degrees of intermesh of the intermeshing elements.

We believe it clear from the foregoing explanation of the relationship between furnishing wheels and the pattern attachments of the patents here in suit that the Courts below were right in their determination that the devices of the patents in suit involve nothing inventive over furnishing wheels of the prior art, or to put the same thing in another way (and in the language of the statute) that the devices of the patents in suit would have been obvious to anyone skilled in this art at the time, and especially so to anyone acquainted with furnishing wheels and the principle underlying their operation.

This conclusion based on consideration of the natures of the devices and their relationship to one another is confirmed by the fact that substantially the same sort of feeding device or pattern attachment was devised at about the same time by several different "inventors" acting independently of one another. This is a factor which many decisions say may be taken into account in determining whether the subject matter should be classified as obvious or not. See, e.g., *Safety Car Heating & Lighting Co.* v. *General Elec. Co.*,

155 F. 2d 937, 939-40 (2 Cir. 1946), *Graham* v. *Jeoffroy Mfg.*, 206 F. 2d 769, 771 (5 Cir. 1953), *Thomson Co.* v. *Ford Motor Co.*, 265 U. S. 445, 452-53 (1924), *McElrath* v. *Industrial Rayon Corporation*, 123 F. 2d 627, 629 (4 Cir. 1941), all cited in the District Court's opinion. See also, to the same effect, *Concrete Appliances Co.* v. *Gomery*, 269 U. S. 177, 185 (1925).

Petitioner says that the independent developments should not have been taken as evidence of obviousness because each of the independent developers made at least one false start, its theory apparently being that anything not achieved until after a false start could not be "obvious." The Constitutional purpose of promoting the progress of science and the useful arts would scarcely be promoted by a rule of law which established as unobvious, and therefore subject to appropriation by patenting, any development which was preceded by a single attempt along some other line. See, in this connection, *Toledo Co.* v. *Standard Parts*, 307 U. S. 350, 356 (1939).

### 3. The Holding of Non-infringement Is Proper and in Accordance with Long-established Law

The basis of the holding of non-infringement is, that in the operation of respondents' pattern attachments no attempt is made to synchronize them with the tufting machines they feed, whereas in the devices of the patents in suit the pattern attachments are synchronized with the tufting machines in such a way as to release a wave of yarn of the desired length for each specific needle stroke. Petitioner complains that this feature is described in the patent specifications and in at least one claim but not in all of them, and that in determining infringement it is the claims that must be looked at to define the patent's scope. While this is true as a generality, it is well settled that infringement or non-infringement is a matter of principle and not

mere words. This Court's succinct statement on the point in *Westinghouse* v. *Boyden Power Brake Co.*, 170 U. S. 537, 568 (1898), is directly applicable, and the non-infringement holding is in full accordance with it:

> "But even if it be conceded that the Boyden device corresponds with the letter of the Westinghouse claims, that does not settle conclusively the question of infringement. We have repeatedly held that a charge of infringement is sometimes made out, though the letter of the claims be avoided. *Machine Co.* v. *Murphy*, 97 U. S. 120; *Ives* v. *Hamilton*, 92 U. S. 426, 431; *Morey* v. *Lockwood*, 8 Wall. 230; *Elizabeth* v. *Pavement Company*, 97 U. S. 126, 137; *Sessions* v. *Romadka*, 145 U. S. 29; *Hoyt* v. *Horne*, 145 U. S. 302. The converse is equally true. The patentee may bring the defendant within the letter of his claims, but if the latter has so far changed the principle of the device that the claims of the patent, literally construed, have ceased to represent his actual invention, he is as little subject to be adjudged an infringer as one who has violated the letter of a statute has to be convicted, when he has done nothing in conflict with its spirit and intent."

## CONCLUSION

Directly applicable here is the rule stated in *Keller* v. *Adams-Campbell Co.*, 264 U. S. 314, 319 (1924):

> "Such an ordinary patent case with the usual issues of invention, breadth of claims and non-infringement, this Court will not bring here by certiorari unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent."

Also, *Graver Mfg. Co.* v. *Linde Co.*, 336 U. S. 271, 275 (1949):

> "A court of law, such as this Court is, rather than a court for correction of errors in fact finding, cannot undertake to review concurrent findings of fact by two courts below in the absence of a very obvious and exceptional showing of error."

The petition should be denied.

Respectfully submitted,

CHARLES H. WALKER
*Attorney for Respondents*
FISH, RICHARDSON & NEAVE
277 Park Avenue
New York, N. Y. 10017

*Of Counsel:*

M. COOK BARWICK
Wilson, Branch, Barwick
and Vandiver
615 Rhodes-Haverty Building
Atlanta 3, Georgia

ALBERT E. FEY
Fish, Richardson & Neave
277 Park Avenue
New York, N. Y. 10017

July 15, 1965

# APPENDIX A

Feb. 12, 1957 R. L. THOMPSON 2,781,007

APPARATUS FOR MAKING PILE FABRICS

Filed March 17, 1953 3 Sheets-Sheet 3

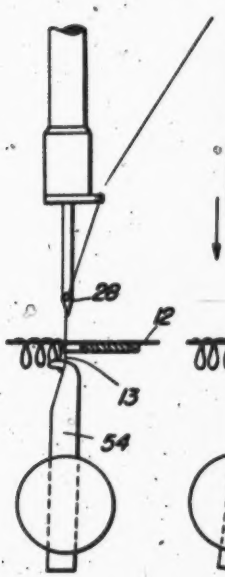



FIG. 5

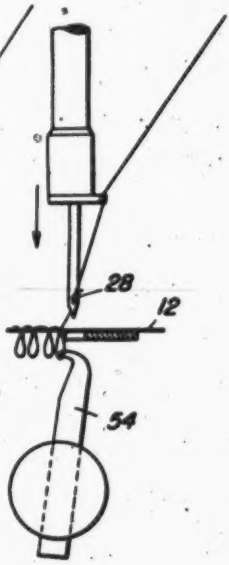



FIG. 6

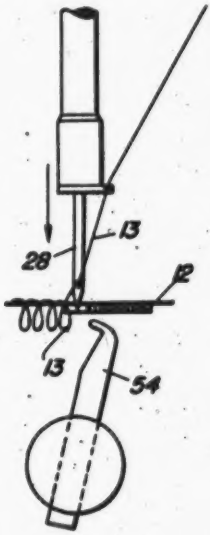



FIG. 7

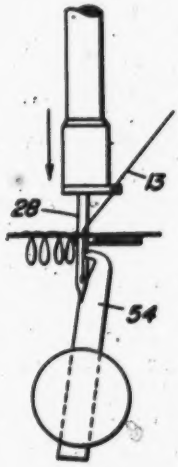



FIG. 8

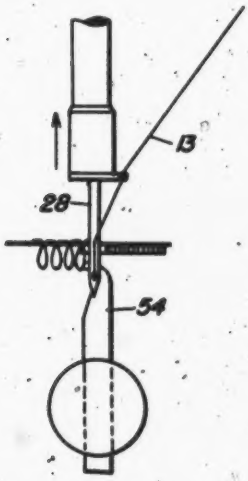



FIG. 9

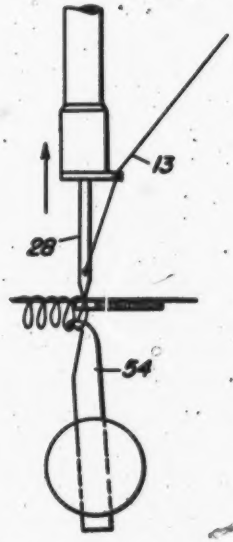
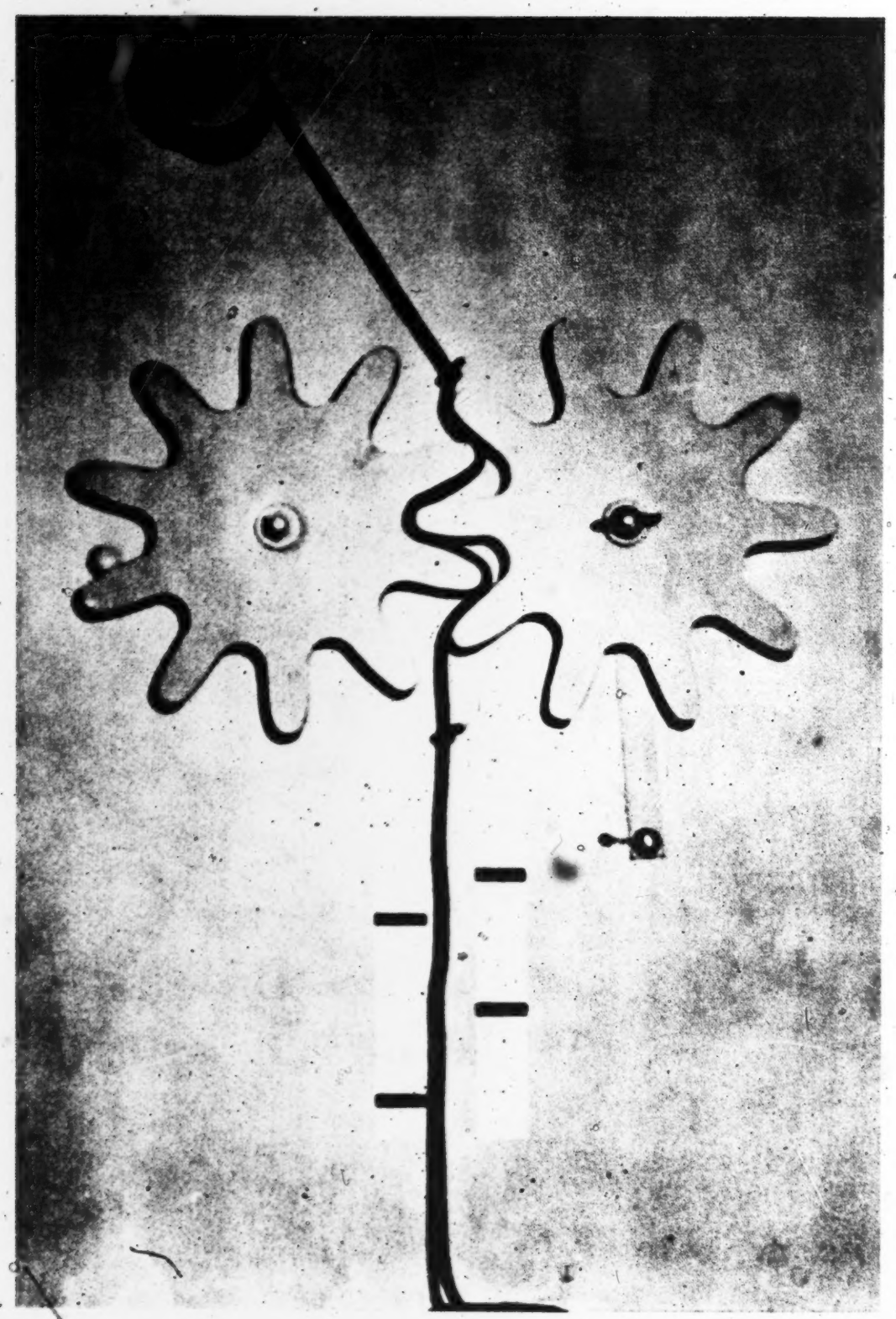



FIG. 10

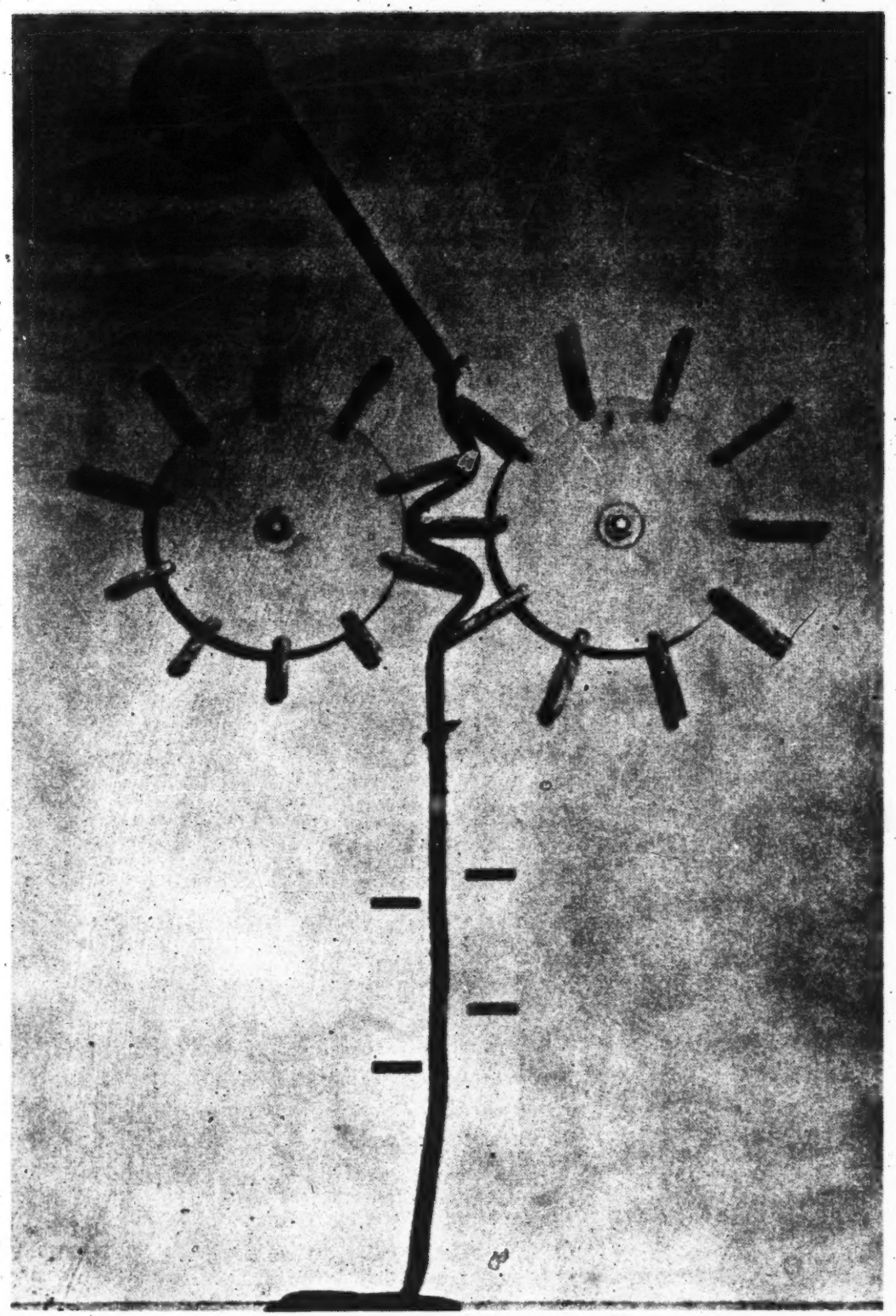
INVENTOR.
Roscoe Lee Thompson
BY
Parmelee, Munson, Morton, Barrow & Taylor

(V 1884)



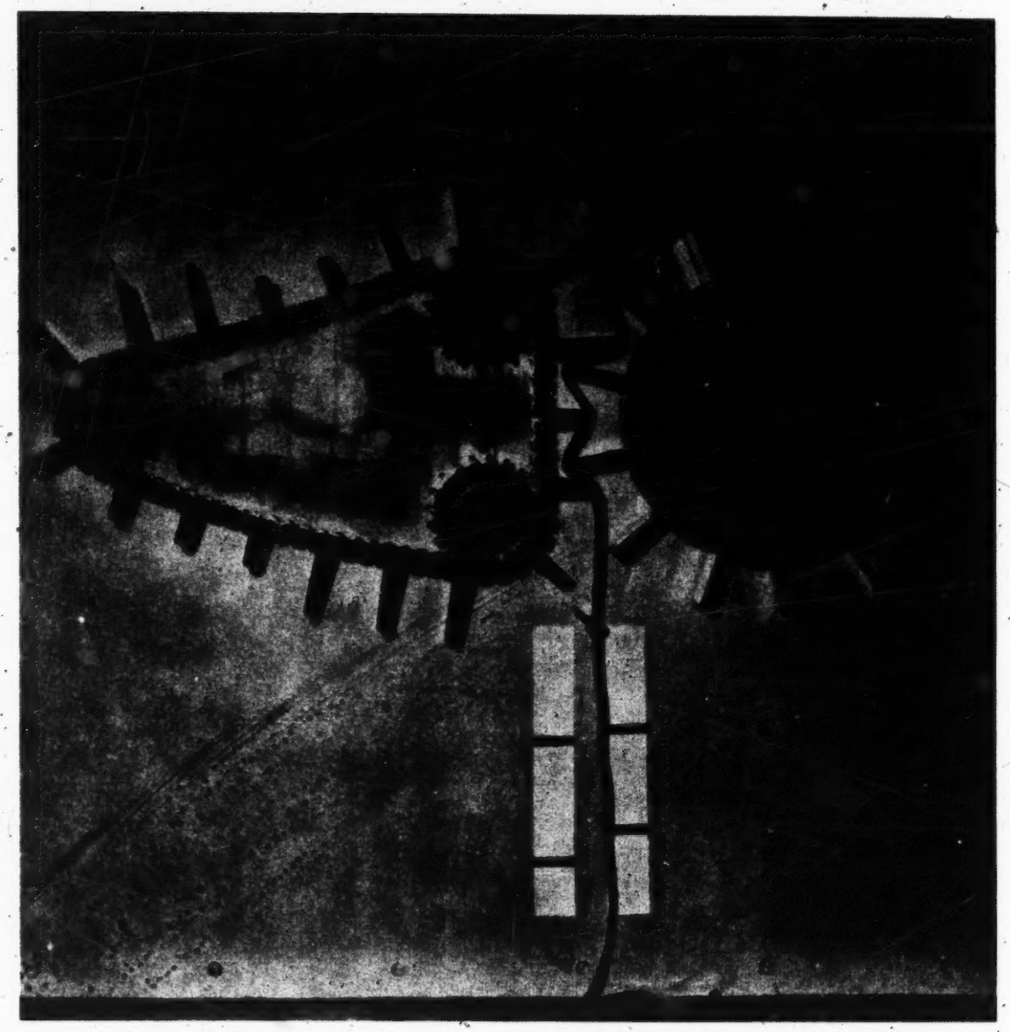
INTERMESHING GEARS
(furnishing wheels)
(DX-5A)

(V 1984)



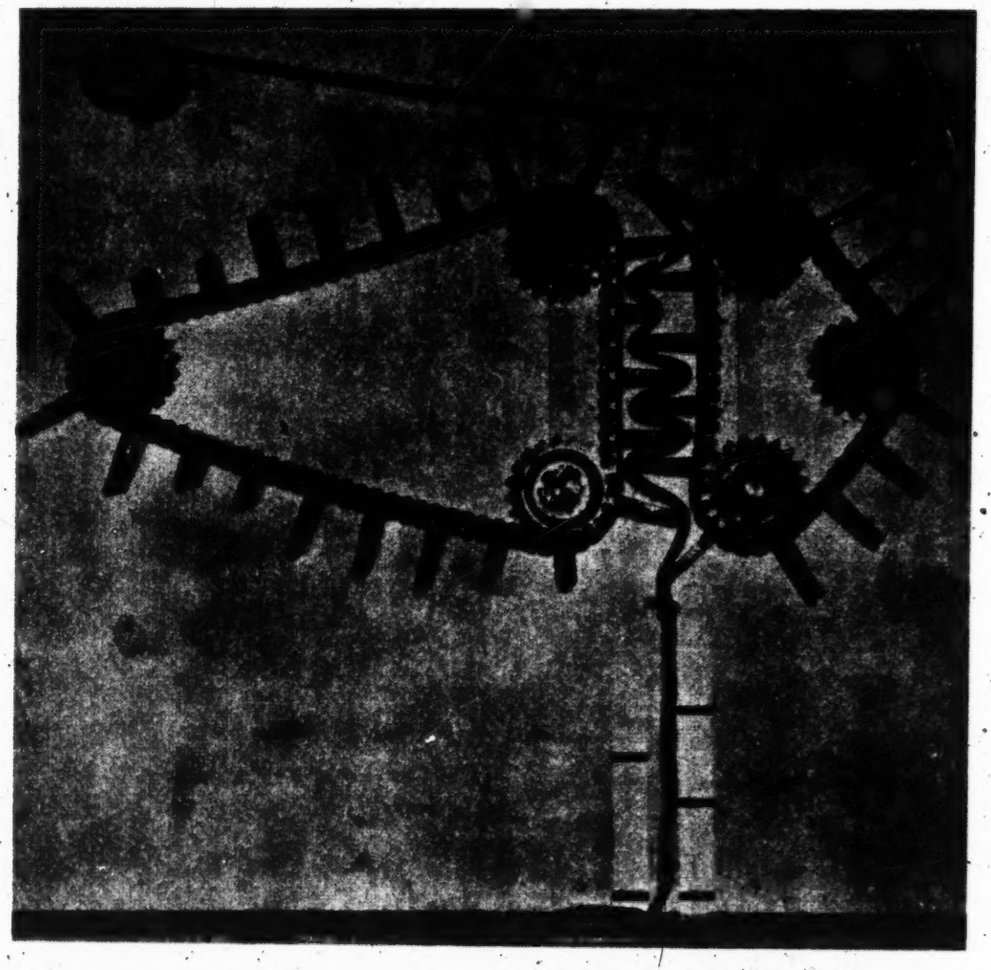
VARIABLE FEED BY INTERMESHING SLATS ON DRUMS
(variable height slats on left-hand drum;
fixed height slats on right-hand drum)
(DX-6A)

(V 1985)



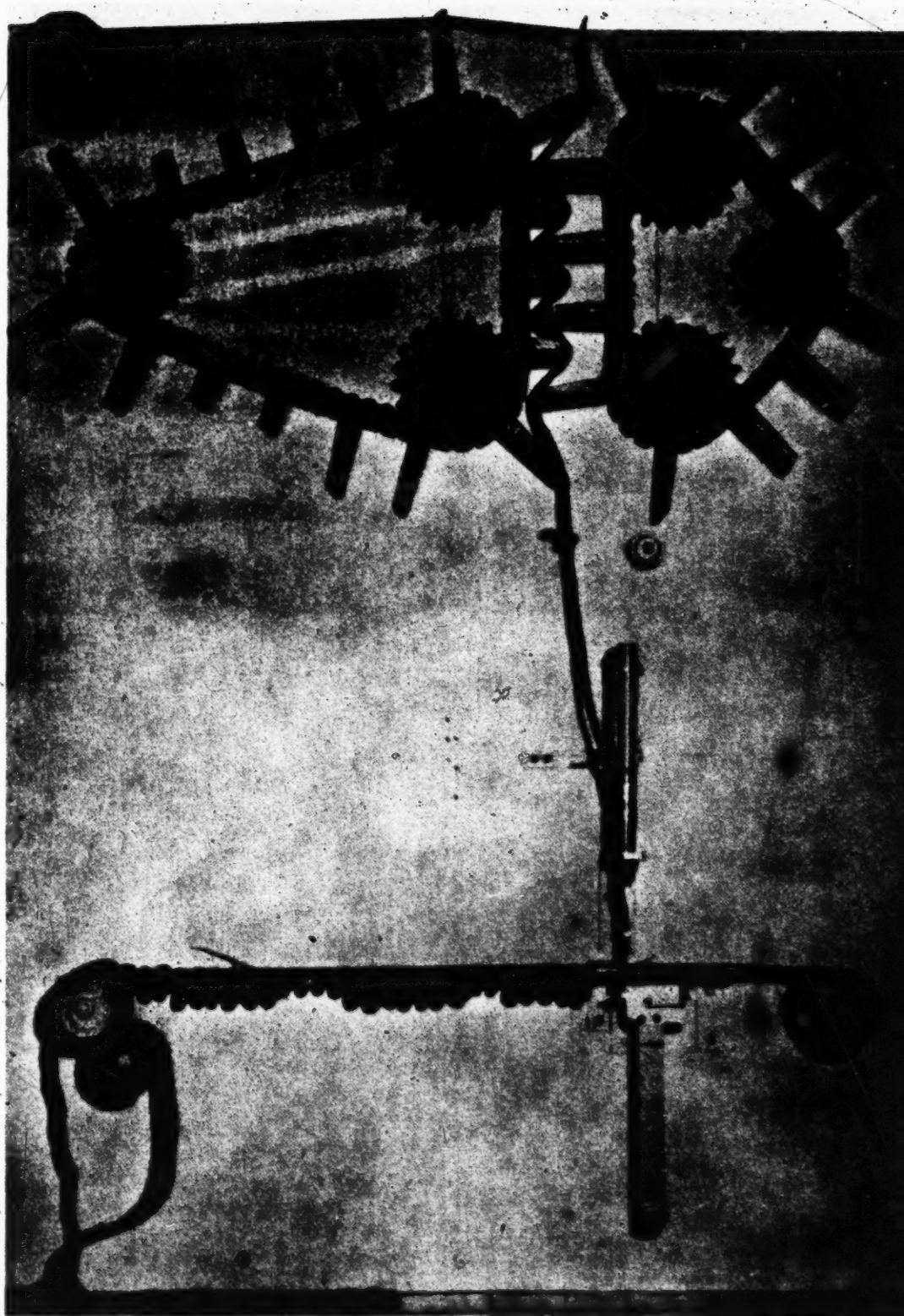
VARIABLE FEED BY INTERMESHING SLATS ON CHAINS OR DRUMS
(variable height slats on chain;
fixed height slats on drum)
(DX-7A)

(V 1986)



VARIABLE FEED BY INTERMESHING SLATS ON CHAINS
(variable height slats on left-hand chain;
fixed height slats on right-hand chain)
(DX-8A)

(V 1987)



MODEL TUFTING MACHINE WITH
SLAT PATTERN ATTACHMENT
(DX-9A)

(V 1988)

LIBRARY
SUPREME COURT, U. S.

Office-Supreme Court, U.S.
FILED
AUG 17 1965
JOHN F. DAVIS, CLERK

IN THE

# Supreme Court of the United States

OCTOBER TERM, 1965

No. 253

MOHASCO INDUSTRIES, INC.,

Petitioner,

*vs.*

E. T. BARWICK MILLS, INC.,

*and*

BARWICK CARPET MILLS, INC.,

Respondents.

## PETITIONER'S REPLY BRIEF

STANTON T. LAWRENCE, JR.,
Attorney for Petitioner,
330 Madison Avenue,
New York, New York 10017.

LESLIE B. YOUNG,
Of Counsel,
330 Madison Avenue,
New York, New York 10017.

ACKERMAN PRESS, Phones BO 9-7107-8

# INDEX


PAGE

Respondents' Comment on the First Reason for Granting the Petition is Misleading and Without Merit ..... 1

Respondents' Comment on the Second Reason for Granting the Petition is Irrelevant ..... 5

Respondents' Comment on the Third Reason for Granting the Petition Misses the Point ..... 10

Conclusion ..... 11


## Table of Authorities


Chicopee Mfg. Corp. v. Kendall Co., 288 F. 2d 719 (4 Cir. 1961), cert. denied 368 U. S. 825 (1961) .....2, 3, 4

Roberts v. Ross, 344 F. 2d 747 (3 Cir. 1965) .....2, 3, 4

Westinghouse v. Boyden Power Brake Co., 170 U. S. 537 (1898) ..... 10


## Statutes


35 U. S. C. § 103 .....5, 7, 10, 11

35 U. S. C. § 135 ..... 9


## Miscellaneous


Webster's Third New International Dictionary ..... 9

IN THE

# Supreme Court of the United States

OCTOBER TERM, 1965

No. 253

MOHASCO INDUSTRIES, INC.,

Petitioner,

*vs.*

E. T. BARWICK MILLS, INC.,

*and*

BARWICK CARPET MILLS, INC.,

Respondents.

## PETITIONER'S REPLY BRIEF

### Respondents' Comment on the First Reason for Granting the Petition is Misleading and Without Merit

Respondents' comment on the first reason for granting the petition (P 11-15)[1], namely, the failure of the District Court to perform its judicial duties with resultant denial of due process to petitioner, describes the actions of the

[1] References to pages in the petition and in the brief in opposition are indicated by "P" and "RB", respectively, followed by the page number.

District Court inaccurately and ignores pertinent parts of the *Chicopee*[2] and *Roberts*[3] decisions.

Respondents state as a fact that the District Court "based its opinion and findings largely on respondents' brief and findings" and "adopted from respondents' pre-trial brief and included in its opinion, much of a discussion of the law concerning the requirement of 'invention'" (RB 2). These statements are half-truths implying that the opinion, except for excerpts from respondents' pre-trial memorandum (I 130-160), was original with and reflected the thought and judgment of the District Court and that the Court prepared findings, some of which had been proposed by respondents.

The fact is that the District Court was not the author of any significant part of the opinion; instead, the opinion is an almost verbatim copy of the first section of a memorandum filed by respondents months before the trial and thus expresses only the thoughts of respondents' counsel. The opinion contains no discussion of the prior art or of the differences between the prior art and the patented devices and says that subject matter of the patents was obvious for the sole reason that three people built slat attachments as soon as the occasion to do so arose (I 61), a reason for which there is no support in either the decisions or the record (P Appendix C).

The District Court prepared no findings but, instead, adopted with inconsequential changes all the twenty-five findings submitted by respondents at the request of the Court. Here again, the Court failed to perform its judicial function and deprived petitioner of the benefit it would have received had the Court written its own findings and studied the record while so doing. A careful examination

---

[2] *Chicopee Mfg. Co.* v. *Kendall Co.*, 288 F. 2d 719, 724.

[3] *Roberts* v. *Ross*, 344 F. 2d 747, 752.

of the record would have prevented the making of the principal findings, on which the conclusions of invalidity and non-infringement are based. Those findings are Nos. 10, 12, 15, and 25, and we showed in the petition (P 8-11) that such findings are all in direct conflict with the record. Respondents have made no answer to our assertions.

Respondents have cited no cases approving the adoption by the District Court as its opinion of a brief written by counsel for the winning party but say (RB 2) that the condemnation of *Chicopee* applied only to the lack of notice to the losing party that the opinion was prepared by the winning party and that both *Chicopee* and *Roberts* upheld the adoption of findings proposed by a party. In support of that statement, respondents quote from *Chicopee* but stop quoting too soon. The court said:

> "... there is no authority in the federal courts that countenances the preparation of the opinion by the attorney for either side. That practice involves the failure of the trial judge to perform his judicial function and when it occurs without notice to the opposing side, as in this case, it amounts to denial of due process."[4]

In the present case, the adoption by the District Court as its opinion of the first section of respondents' pre-trial memorandum without significant change was the equivalent of having the opinion prepared by respondents' counsel, since the opinion was not the product of the performance by the trial judge of "his judicial function". Petitioner received a copy of respondents' memorandum at the time it was filed but was never given any notice that the District Court had utilized a part of the memorandum as its opinion. The conduct of the District Court thus falls within both parts of the condemnation of *Chicopee*.

---

[4] *Chicopee* v. *Kendall*, 288 F. 2d 719, 724.